



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

7590 02/24/2004

Attention: Yen Tong Florczak
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
----------	--------------

1615

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,054

Applicant(s)

MALLO ET AL.

Examiner

Blessing M. Fubara

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of amendment filed 11/17/03.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 15-28 recite the limitation "the cosmetic article" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claims 13 and 14 do not recite "cosmetic article."

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 13-16, 18-20, 22, 23 and 25- 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (US 3,941,733).

Chang teaches dispersions of poly (urethane-urea) terminated by hydrolysable or hydrolyzed silyl groups (abstract). The dispersion further comprises solubilizing groups, which are groups that ionize in water such as carboxyl, sulfate sulfonate, phosphonate and quaternary ammonium compounds (column 3, lines 1-6). Isocyanate, specifically diisocyanate, polymeric polyol, silyl compound, e.g. X₃Si-compound, ethylene glycol polyfunctional chain extender, and water solubilizing compound react to form polyurethane-urea dispersions in water (column 3,

Art Unit: 1615

line 14 to column 4, line 4 and column 6, lines 26-31). Terminal silyl groups are listed in column 7, lines 11-25 and all but one are clearly the silyl groups recited in claim 7 of the instant invention. Ammonium carboxylates are disclosed as water-soluble thermoplastic compounds (column 7, lines 49-65).

Cosmetic in "cosmetic article" is the intended use of the article. The article is composed broadly of polyurethane-urea polymer that is functionalized with hydrolysable silyl group. Any composition that meets this limitation would anticipate the claim and the future intended use of the composition or the article is not specific/critical to the broad composition or article.

Regarding claims 20 and 27, the polyurethane-urea polymer of the prior art would inherently have the self-adhesive properties of the composition of the instant invention and thus form a film that would have a thickness of 0.025 mm when coated and dried because the prior art teaches the composition of the instant invention.

Chang clearly teaches the limitations of the instant claims.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 3,941,733).

Chang clearly teaches a polyurethane-urea terminated by hydrolysable or hydrolyzed silyl groups but fails to teach the molecular weight of the polyol. Since Chang is silent on the molecular weight of the polyol, Chang teaches all molecular weights. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare

Art Unit: 1615

composition of polyurethane-urea terminated by hydrolysable or hydrolyzed silyl groups and perform the chain extender reaction with polyols of all or any molecular weight because the silence in the prior art of the molecular weight of the polyol permits the use of polyol with any molecular weight. The use of a polyol that has a molecular weight in the range of about 200-5,000 is not inventive over the prior art in the absence of showing to the contrary. The recitation of "cosmetic article" is an intended use for the article.

8. Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 3,941,733) in view of Gaa et al. (US 4,567,228).

Chang discloses a composition that comprises polyurethane urea that is functionalized with silyl group. Chang does not disclose that the composition contains pigments or surfactants, plasticizers, antioxidants, fillers and other additives. However, Gaa discloses a coating composition that comprises polyurethane urea that is functionalized with silyl group and pigments, surfactants, plasticizers, antioxidants, fillers or other additives. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the composition of Chang. One having ordinary skill in the art would have been motivated to modify the composition of Chang by including the additives of Gaa with the expectation that composition will be plasticized by the additives.

9. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Art Unit: 1615

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 242-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1615

